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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of: **Yasushige NAKAMURA et al.**

Group Art Unit: **1756**

Serial Number: **09/935,668**

Examiner: **Janis L. Dote**

Filed: **August 24, 2001**

Confirmation Number: **1050**

For: **IMAGING COLOR TONER, COLOR-IMAGE FORMING METHOD
AND COLOR IMAGE FORMING APPARATUS**

Attorney Docket Number: **011071**

Customer Number: **38834**

REPLY BRIEF

Mail Stop: Appeal Brief – Patents

October 30, 2006

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed August 31, 2006, Appellant submits the following Reply Brief.

APPELLANT'S ARGUMENT

Appellant presents the following statements in response to the Examiner's Answer:

1. Claims 1, 3-5, 7, 9-11, 13, 14 and 18-22 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention.

2. The Examiner asserts that because the specification (incorrectly) indicates in various places that its second polyester resins are "non-linear", the language of the specification does not generally support the claimed second polyester resins that are alternatively claimed as "linear", "non-crosslinked", and "prepared in the absence of a crosslinking component".

The Examiner asserts that there are only three Examples in the specification that show the use of a second *linear* polyester resin, and asserts that these three Examples alone are inadequate support for the claimed limitations with respect to the second polyester resin.

3. Appellant has asserted that the specification was in error, that the second polyester resin should have generally been described throughout the specification as "linear", rather than "non-linear". Appellant asserts that if the specification is correctly seen as describing the second polyester resin as linear *both* in the specific examples *and generally throughout the*

specification, then support for the claimed second polyester resins is more easily identified, and should not be limited to the disclosed specific polyesters.

4. With respect to proving that the specification broadly describes the second polyester resin as linear, Appellant has asserted that one skilled in the art, upon reading the specification, would not only recognize that the term “non-linear” should have been “linear” throughout the specification as originally filed.

4. "A change to correct an error is not considered new matter if 'one skilled in the art would appreciate not only the existence of an error in the specification but what the error is.'" In re Oda, 443 F.2d 1200, 1206 (1971).

5. Appellant refers to the Declaration of Dr. Masatoshi Kimura dated August 5, 2003, which indicates that the Declarant, upon reading the specification, both easily recognized that an error was apparent, and also easily recognized what the correct meaning should have been; i.e., that the term “non-linear” when describing the second polyester resin was incorrect, and should have been “linear”.

6. The Examiner has deemed the Declaration as not persuasive, and asserted that Declarant has failed to indicate what property of the second polyester resin disclosed in the original specification would have led a person having ordinary skill in the art to recognize clearly

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that the disclosed second polyester resin could only have been a “linear” or “non-crosslinked” polyester resin.

In response, Appellant notes that Dr. Kimura noted the use and non-use of crosslinking agents in all of the examples in the specification, i.e., Polyesters 2-1 to 2-5, which were produced by reaction of only monomers in the absence of crosslinking agents, and concluded that such second polyester resins are non-crosslinked polyester resins having a linear structure. Since such linear resins could not have been properly described as non-linear, but were so described, one skilled in the art could only reason that the specification was in error.

5. Therefore, Appellant submits that the Declaration should be deemed persuasive that one skilled in the art would realize that the description of the non-crosslinked polymer as “non-linear” was an error, and would realize that the error was in calling the second polymer “non-linear”.

7. If the specification is read with the above correct interpretation of the second polyester resin as being “linear”, Appellant submits that there is significantly greater support for the claimed linear second polyester resins than the recited Examples in the specification. Appellant submits that the claimed second polyester resins are broadly supported, and they should not be limited to the disclosed specific polyesters.

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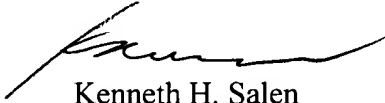
Summary

Appellant has demonstrated that the specification should be seen as broadly supporting the claimed second linear polyester resins, because the declaration of Dr. Kimura has persuasively shown that the specification is easily seen as describing all of the second polyesters similarly. Appellant asserts that with this significantly greater support for the claimed polyester resins, the rejections over 35 U.S.C. §112, first paragraph have been overcome.

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If any additional fees are due in connection with this submission, please charge Deposit Account No. 50-2866.

Respectfully submitted,
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